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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,030	03/02/2001	Horst Hintze-Bruning	IN-5453	7425

7590

07/05/2002

Basf Corporation  
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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 07/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

MF-7

## Office Action Summary

Application No.

09/762,030

Applicant(s)

HINTZE-BRUNING ET AL.

Examiner

Lawrence D Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
 Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Claim Rejections: 35 USC 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 12 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 12 and 17 provides for the use of a film, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 12 and 17 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections – 35 USC § 102(b)***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3-4, 9-12 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Leach (U.S. 5,338,578).

5. Leach discloses a molded substrate comprising a first coating powder film with a second coating applied to the first film (abstract) having a thermally curable coating while heating the powder coating to initiate crosslinking (column 5, lines 15-25). Leach teaches the powder coating will melt and flow out on the substrate (column 5, lines 911). The reference discloses drying the coated substrate (column 6, lines 5-10).

***Claim Rejections – 35 USC § 103(a)***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-2, 6, 8 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leach (U.S. 5,338,578).

8. Leach discloses a molded substrate comprising a first coating powder film with a second coating applied to the first film (abstract) having a thermally curable coating while heating the powder coating to initiate crosslinking (column 5, lines 15-25) which is a surfacer composition. Leach teaches the powder coating will melt and flow out on the substrate (column 5, lines 911) and a melting point temperature of 150 C (column 5, lines 18-35). Leach does not disclose thickness of the substrate or powder coatings. The thickness of the substrate is an optimizable feature as it controls the flexibility of the film. It would have been obvious to one of ordinary skill in the art to optimize the components because discovering an optimum or workable range involves routine skill in the art. Evidence of unexpected properties may be in the form of a direct or indirect comparison of the claimed invention with the closest prior art which is commensurate in scope with the claims. See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

***Claim Rejections – 35 USC § 103(a)***

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leach (U.S. 5,338,578) in view of Craun et al (U.S. 6,184,281).

10. Leach is relied upon for claims 1-4, 6, 8-12 and 15-16. Leach does not disclose a removable film. Craun teaches a coating composition suitable for coating plastic substrates where the coatings are easily removable (abstract) and are made of powder

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coatings (column 2, line 30). Leach and Craun are analogous art because they are from the same field of coated substrates. It would have been obvious to one of ordinary skill in the art to include the removable coating (film) to at least one powder coating layer of Leach because Craun teaches the removable coatings are recyclable (abstract) and are therefore environmentally safe.

***Claim Rejections – 35 USC § 102(b)***

11. Claims 1-5, 9, 11, 13-14, 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0844286.

12. EP '286 discloses filmed powder coatings for substrates made of plastics (abstract) where the coatings are dry and free flowing (page 2, line 17) and have a melt temperature of 200 F (93.33°C) (page 2, lines 44-47). EP '286 discloses thermally cured powder coatings comprising a crosslinker (page 4, lines 36-53) where the substrates are used as furniture (page 12, line 10), which are domestic appliances.

***Claim Rejections – 35 USC § 103(a)***

13. Claims 1-9, 11, 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0844286 in view of Craun et al (U.S. 6,184,281).

14. EP '286 discloses filmed powder coatings for substrates made of plastics (abstract) where the coatings are dry and free flowing (page 2, line 17) and have a melt

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temperature of 200 F (93.33°C) (page 2, lines 44-47). EP '286 discloses thermally cured powder coatings comprising a crosslinker (page 4, lines 36-53) which is a surfacer composition. The substrates are used as furniture (page 12, line 10), which are domestic appliances. Leach does not disclose thickness of the substrate or powder coatings. The thickness of the substrate is an optimizable feature as it controls the flexibility of the film. It would have been obvious to one of ordinary skill in the art to optimize the components because discovering an optimum or workable range involves routine skill in the art. Evidence of unexpected properties may be in the form of a direct or indirect comparison of the claimed invention with the closest prior art which is commensurate in scope with the claims. See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). EP '286 does not disclose removable film. Craun teaches a coating composition suitable for coating plastic substrates where the coatings are easily removable (abstract) where the coatings can be powder coatings (column 2, line 30). Leach and Craun are analogous art because they are from the same field of coated substrates. It would have been obvious to one of ordinary skill in the art to include the removable coating (film) to at least one powder coating layer of EP '286 because Craun teaches the removable coatings are recyclable (abstract) and are therefore environmentally safe.

### ***Conclusion***

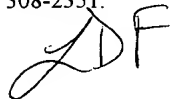
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703)

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305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson  
Examiner  
Art Unit 1774

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
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